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OFFICE OF PETITIONS

In re Application of :
Ayala et al. :
Application No. 09/545288 : DECISION ON PETITION
Filing or 371(c) Date: 04/07/2000 : UNDER 37 CFR 1.55(c)
Attorney Docket Number: 032326-057 :
:

This is a decision on the petition 37 CFR 1.78(a)(3) and 37 CFR 1.55(c), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c), and under 35 U.S.C. § 119(a)-(d) for the benefit of priority to the prior-filed applications set forth in the Amendment and Application Data Sheet (“ADS”), filed with the present petition, filed April 29, 2009.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii).

37 CFR 1.78(a)(2)(ii) indicates that the time periods set forth therein do not apply if the later-filed application is: (1) an application for a design patent; (2) **an application filed under 35 U.S.C. § 111(a) before November 29, 2000**; and (3) a nonprovisional application which entered the national stage after compliance with 35 U.S.C. § 371 from an international application filed under 35 U.S.C. § 363 before November 29, 2000.

Since this application was filed under 35 U.S.C. § 111(a) before November 29, 2000, the provisions of 37 CFR 1.78(a)(3) for acceptance of a late claim for priority do not apply to the subject nonprovisional application. Accordingly, the petition is **DISMISSED AS INVOLVING A MOOT ISSUE**.

In view of the above, the fee submitted is unnecessary, and will be refunded to petitioner's deposit account in due course.

It is noted that the Amendment filed with the present petition improperly incorporates by reference the prior applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application

after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Any questions concerning this matter may be directed to Attorney Derek Woods at (571) 272-3232.

This application is being returned to Technology Center Art Unit 3729 for processing of the Amendment filed with the present petition, and for continued examination in the normal course of business.



Anthony Knight
Supervisor
Office of Petitions